



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,546	12/05/2001	Gregory Allen	24120-11	7229
7590	12/02/2003			
Mark Montague, Esq. Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036				
EXAMINER CAPUTO, LISA M				
ART UNIT 2876				
PAPER NUMBER				

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,546

Applicant(s)

ALLEN, GREGORY

Examiner

Lisa M Caputo

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 111603.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 11172003.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment, affidavit, and drawing corrections filed 28 August 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szabo (U.S. Patent No. 5,864,125) in view of Hohle et al. (U.S. Patent No. 6,101,477, from hereinafter "Hohle").

Szabo teaches a navigation system data entry card having imprinted pictorial and bar code navigation information. Szabo discloses that on one hand, the solution is the universal data input card that contains navigation data and/or information on a pre-determined destination point. The essence of the invention is that the data and/or information are recorded on the surface of the card as surface visual information in a form totally readable with the naked eye and/or by electro-optical methods. The card is preferably made of paper and information are printed on the surface of the card. The geographical coordinates in bar-code form, miniature map segments, a picture of the destination, a short description of the destination point, and other useful data and information, are printed in an arranged typographical format on the surface of the card.

As part of a printed product the cards can be easily removed from the publication along contour lines or perforation. Secondary destination points are indicated in different colors and/or signs on the map segments. The other component of the invention is a GPS device capable of reading the universal data input card. The device consists of a central processing unit (CPU), a satellite receiver unit and a data input unit connected to the CPU input, and a display unit connected to the CPU output. The essence of the GPS device according to the invention is that the data input unit is an electro-optical reader which converts surface recorded visual information into electrical signals. In the simple, advantageous form of the equipment the data input unit is a bar-code reader which can only be used for simple navigation mission. In its more advanced form the data input unit consist of an electro-optical scanner unit that can read all information from the map segments recorded on the card, therefore assuring comfortable navigation along the route. The scanner can read any data and information from the card, so the unit can display the photograph on the visual display and the voice synthesizer can announce the text information, if necessary. The equipment has a visual display, with alphanumeric and graphic capability. The display unit can be equipped with an optional speech synthesizer--sound signaling unit (see col 2 line 40 to col 3 line 9).

Further, Szabo discloses FIG. 4 shows a preferred embodiment of the GPS device combined with the card reader. The device can be turned on by the main switch 5. The card input slot 7 enables the insertion of the card. The display 6, showing various information to the driver is on the front panel of the GPS device. In the FIG. 4 the display 6 is shown in an operating mode, when it displays the distance to the destination

and the closest way point distance and the directions. If the driver travels outside the area covered by the map, the GPS device automatically changes operation mode and the display 6 shows the linear distance to the destination and its direction. In this case the direction of the destination point is displayed in an angle relative to the movement of the vehicle. FIG. 5 shows the block diagram of the GPS device according to the present invention. The receiver unit 8 receives the satellite signals via the antenna. The data input unit 9 reads the map segments 2 and the bar-code 1 printed on the card. The CPU 10 compares the current position based on satellite signal to the destination position based on the card data and calculates the data needed by the driver. The visual display 11 shows information for the driver. The speech synthesizer--sound signaling unit 12 gives verbal and sound information for the driver. The CPU 10 determines the real position of the vehicle with reference to the destination coordinates and performs all navigation calculations. The CPU 10 consists of a microprocessor and its functions are controlled by a program stored in the memory of the CPU 10. The receiver unit 8 receives satellite signals via the antenna. After amplifying and demodulating the radio signals, the receiver unit 8 provides data on the position of the vehicle to the CPU 10. The receiver unit 8, produced in several forms which is an important part of the GPS device. In accordance with the quality category of the GPS device, multiplex or sequential receiver units with a small or large number of channels can be used. In case of simple GPS device, the data input unit 9 consists of a miniature bar-code reader. This reader can only read the bar-code 1 information printed on the card. The geographical coordinates contained in the bar-code 1 are read into the CPU

10 where they are compared to the actual vehicle position received from the receiver unit 8. On the basis of the two position coordinates, the CPU 10 determines the direction and distance of the destination point (as recited in claims 18 and 24 of the instant application), and sends the result to the display unit. The device is also capable of tracking the movements of the vehicle, so the direction of destination is displayed relative to the movement of the vehicle. The visual display 11 shows the computed direction graphically, while the distance to destination is displayed numerically. Bar-code readers are widespread in both industrial and everyday use, therefore a modified version of the bar-code reader can be easily engineered (see Figures 4-5, col 4 line 52 to col 5 line 37). It is possible to produce the cards in a collection suitable for circulation in book form where the interests, hotels, restaurants etc. can be published, illustrated with color photos and completed with useful information relevant to a given area (see col 6, lines 52-56). The collection of cards that showcases different items shows that the travel system is useful at events with vendors, as recited in independent claims 16 and 21 and their dependent claims 18-20 and 22-24. Regarding claim 13, the GPS system is known in the art to be able to track different types of trips and locations (including second trips after the card is returned as recited in claims 4 and 11 of the instant application), and would be useful for travel by ship.

Hence Szabo teaches a system for supplying information about a physical location visited during traveling by a user through the global positioning system (GPS). The system includes a card (portable device to be carried by a human user), the GPS device system (travel service company for delivering a user to a destination and for

providing the portable device to the user for use during the visit to the destination), card reader and receiver unit 8 (reader adapted to read the information of the portable device), and a CPU (the control center for receiving the identification information identifying the identity of the physical location and associating the received identification information, while supplying additional fulfillment information), as recited in claims 1-7.

Regarding claims 1-29, Szabo fails to teach that the portable device and reader both have unique identification codes used throughout the system.

Hohle teaches a method and apparatus for a travel-related multi-function smart card. Hohle discloses that the present invention provides methods and apparatus for a smartcard system which securely and conveniently integrates important travel-related applications, thereby overcoming the limitations of the prior art. In accordance with one aspect of the present invention, a smartcard system comprises a cardholder identification application and various additional applications useful in particular travel contexts; for example, airline, hotel, rental car, and payment-related applications. In accordance with another aspect of the present invention, a smartcard system further comprises space and security features within specific applications which provide partnering organizations the ability to construct custom and secure file structures (see col 2 lines 23-35). Further, Having thus described an exemplary smartcard 100 and IC 110, an overview of a smartcard file structure in accordance with the present invention will now be described. Referring now to FIG. 4, file structure 400 is preferably used to store information related to card-holder preferences and various data useful for securing and paying for air travel, rental cars, hotel reservations and the like. More particularly,

file structure 400 preferably comprises cardholder ID application 406, payment system application 408, airline application 410, hotel system application 412, rental car application 414, and cardholder verification data 404. It will be appreciated by those skilled in the art that the term "application" in this context refers to self-contained regions of data all directed at a particular function (e.g., airline, hotel, etc.) rather than a block of executable software code, although the use of executable modules as part of any particular application falls within the scope of the present invention. Cardholder verification data 404 preferably houses data useful in verifying cardholder identity during a transaction. In a preferred embodiment, cardholder verification data 404 comprises two eight-byte cardholder verification numbers (i.e., PIN numbers) referred to as CHV1 and CHV2. The ID application also holds additional files related to personal information of the user (see Figure 4, col 5, lines 1-30). Hence, Hohle teaches identification codes for the personal device.

Further, Hohle teaches that referring now to FIG. 10, smartcard 100 is suitably used in the context of a distributed transaction system. Briefly, cardholder's may employ smartcard 100 at various access points 15 which are connected via network 19 to an issuer 10 and at least one partnering organization 12. Issuer 10 suitably comprises various hardware and software components suitable for client host communications as well as a database system 11. In this context, the term 'issuer' refers to the organization that actually issues the smartcard and retains some high-level access to certain areas of file structure 400 (detailed below). Partnering organizations 12(a), 12(b), and so on, comprise the various hotel chains, rental-car agencies, airlines, and

the like, who have access to appropriate data regions within smartcard 100. Each partnering organization 12 suitably comprises a database 13 and appropriate hardware and software components necessary for completing a transaction over network 19. Network 19 may comprise one or more communication modes, e.g., the public switched telephone network (PSTN), the Internet, digital and analog wireless networks, and the like. Each access point 15 suitably comprises an appropriate card reader for interfacing with smartcard 100 as well as hardware and software suitable for interfacing with a cardholder and performing a transaction over network 19. Access points 15 are preferably located in areas providing convenient access for traveling cardholder's or cardholder's preparing travel arrangements. Such access points 15 may be located, for example, in airline ticketing and gate areas, rental car facilities, hotel lobbies, travel agencies, and stand-alone kiosks in malls. In addition, businesses might see fit to host an access point 15 to streamline their employees' business travel. Furthermore, an individual cardholder might configure his or her personal computer to act as an access point using appropriate software and peripheral hardware (see Figure 10, col 5 line 64 to col 6 line 32). Hence, Hohle teaches identification codes for the reader via suitable access points.

In view of the teaching of Hohle, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a personal identification number as a unique identification code for the device and reader so as to ensure security of the system and validity of the user. It is important to verify the user so that the travel system is used appropriately by the proper user in order to maintain a stable

system without fraudulent interruptions. The system as set forth by Szabo/Hohle teaches a system for providing information to a user via a card/card reader during travel and encompasses the invention as claimed in claims 1-23 of the instant application.

Regarding claims 5 and 12, Szabo fails to teach that the user can be kept anonymous.

Hohle teaches that cardholder verification data 404 preferably houses data useful in verifying cardholder identity during a transaction. In a preferred embodiment, cardholder verification data 404 comprises two eight-byte cardholder verification numbers (i.e., PIN numbers) referred to as CHV1 and CHV2 (see Figure 4, col 5, lines 1-30). These PIN numbers can be used as the entire identification for the user, so that the person's identity is not revealed.

In view of the teaching of Hohle, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a number to associate with a customer and not the customer's actual identity in order to ensure a secure system (i.e. a person can travel to the places desired without the ability to be followed). It is favorable to have numbers identifying the users so there is also security that the correct people are using the system.

Regarding claims 7 and 15, Szabo fails to teach that there is a travel record kept for places traveled.

Hohle teaches that the ID application also holds additional files related to personal information of the user (i.e. travel records) (see Figure 4, col 5, lines 1-30).

In view of the teaching of Hohle, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a travel record in order to keep accurate data for security purposes (i.e. to ensure the correct people and places are using the system).

Regarding claim 25, Szabo fails to teach that the user is identified by personal information such as an address.

Hohle teaches that cardholder ID application 406 suitably comprises various files related to personal information of the cardholder (e.g., name, addresses, payment cards, driver's license, personal preferences and the like) (see Figure 4, col 5, lines 25-30).

In view of the teaching of Hohle, it would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain user information such as an address to identify a user because this information is specific and pertains to the person, and hence it is easy to establish a correct identity.

Response to Arguments

3. The affidavit filed on 28 August 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hohle reference.

4. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Hohle reference. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Hohle reference. While conception is

the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hohle reference to either a constructive reduction to practice or an actual reduction to practice.

The applicant has failed to satisfactorily provide documented proof/evidence that the claimed invention (filed on December 5, 2001 with a provisional application filed December 6, 2000) existed or was in process before the filing date of the prior art (U.S. Patent No. 6,101,477 to Hohle, et al., from hereinafter "Hohle" (published on August 8, 2000 and filed on January 23, 1998). The applicant admitted in the sworn declaration that "There is an absence of detailed evidence that establishes conception of the particular invention claimed in the present application prior to January 23, 1998, since, as an artist, it has been my style and practice not to retain written notes and also to generally use a chalk-board (or equivalent) during the course of my thought process...and have generally not maintained dated notebooks or other dated materials" (see paragraph 2, lines 3-8). Further, the applicant submits "...attached are copies of some notes pertaining to some general aspects, although, such notes, by themselves, do not definitively establish conception of the invention claimed in the present application" (see paragraph 2, lines 11-13). The documentary evidence (copies of some general notes) are vague and do not pertain to the instant application as claimed,

and are not valid because "conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended" (see above). The examiner respectfully denies the effectiveness of the affidavit as the declaration, along with the attached documentary evidence, is not sufficient to antedate the January 23, 1998 filing date of the Hohle reference. See MPEP, 37 CFR 1.131.

5. In response to applicant's argument that the Hohle reference is not prior art under 35 U.S.C. 102(b) examiner respectfully submits that the rejection is made under 35 U.S.C. 103(a). The Hohle reference (published August 8, 2000 and filed 23 January 1998) is indeed valid as prior art under 35 U.S.C. 103(a) as it was filed prior to the provisional priority date of the instant application (December 6, 2000) (in addition, the affidavit did not antedate this reference). Hence, the rejection of claims 1-23 stands, and newly added claims 24-29 are also rejected by Szabo in view of Hohle. See 35 U.S.C. 103 rejections above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2876

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(703) 308-8505**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lisa.caputo@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


LMC

November 17, 2003



DIANE I. LEE
PRIMARY EXAMINER